

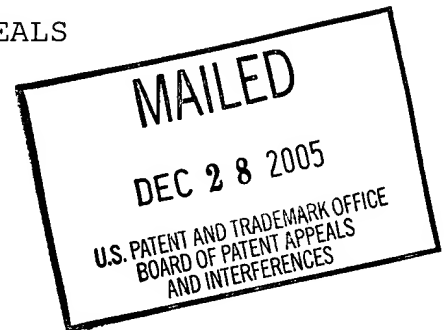
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
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Ex parte GERVASIO MERCURI  
\_\_\_\_\_

Application No. 09/869,094  
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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER  
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This application was electronically received at the Board of Patent Appeals and Interferences on October 19, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

A review of the file indicates that on March 23, 2005, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on March 23, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed March 23, 2005:

- 1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more

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information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

EXAMINER'S ANSWER

On June 13, 2005, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that the references applied in the Examiner's Answer were not listed under the heading "Evidence Relied Upon" as set forth in the Manual of Patenting Examining Procedure (MPEP) § 1207.02. Accordingly, correction of the Examiner's Answer is required.

Accordingly, it is

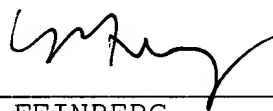
ORDERED that the application is returned to the examiner to:

- 1) hold the Appeal Brief filed on March 23, 2005, defective;
- 2) to notify appellants to file a supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) to vacate the Examiner's Answer mailed June 13, 2005, to consider the substitute Appeal Brief; and submit a revised Examiner's Answer including the references being applied under the heading "Evidence Relied Upon;" and
- 4) for such further action as may be appropriate.

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It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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